



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,825	08/16/2001	Barbara A. Blair	10010714 - 1	3281

7590 03/25/2008
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
----------	--------------

3689

MAIL DATE	DELIVERY MODE
-----------	---------------

03/25/2008 PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/931,825	BLAIR ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 December 2007.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-6 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

Applicant's response of 12/27/07 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant should take notice that the claims are rejected for multiple reasons as set forth below.

For claims 1,2,5,6, the claims are not considered to be reciting statutory subject matter. 35 USC 101 limits the types of subject matter that is eligible for patent protection. Not all methods are patentable under 35 USC 101. Claim 1 and 2 are reciting a method that involves only humans and human intelligence in executing the claimed steps. A process type of statutory claim must be either (1) tied to a particular apparatus, or (2) operated to change materials to a different state or thing. Claims 1 and 2 are not tied to any particular apparatus and do not operate to change anything from one state to another. As stated in the recent decision by the Federal Circuit in the case of *In re Stephen W. Comiskey*, “*mental processes, or processes of human thinking, standing alone are not patentable even if they have a practical application.*” The instant claims are not tied to another statutory class of invention and depend 100% on the use of human mental processes. The application of humans and their minds/intelligence to solve practical problems is not in and of itself patentable. Claims 1 and 2 are considered non-statutory for this reason.

For claims 1,2,5,6, the examiner does not find that the process produces a useful, tangible, and concrete result. All of the steps are totally dependent on people and their intelligence/minds in making certain decisions. The specification provides no guidance whatsoever as far as how this process is to be accomplished. The specification is lacking in guidance to such an extent that the claimed process is not considered to be repeatable to any substantial degree that would allow the same results to be achieved (i.e. concrete) or arrived at. The process is not concrete. As far any alleged result is concerned, the examiner does not feel that there is any tangible result to what is claimed. The language claiming “developing products” does not even require anything to be produced in the real world. The developing products step can be just a mental step of thinking about what products can be made (i.e. mental development). The term “developing” does not require that any products are actually manufactured or produced. This claimed process does not result in a useful, tangible and concrete result as is required by 35 USC 101, where the tangible and concrete aspects are lacking.

For claims 5,6, additionally, there is no result occurring when you just task a group with a thing to do. It does not require that they actually do anything. People are tasked to do things all the time, but frequently nothing is done and there is no result to the step of tasking. To claim that a group is “tasked” is not a process that even has a result. The examiner believes that claim 5 is more clearly lacking in a concrete, useful, and tangible result. There is no result at all.

For claims 3,4, the “system” as claimed is not statutory. None of the elements claimed fall into any one of the allowable statutory classes of invention so the claim is

not directed to statutory subject matter. The “groups” claims are really people, which are not allowed to be claimed in apparatus types of claims. The “goals” that are claimed are not even real world tangible things, they are intangible concepts. The “process” that is claimed is not a real world tangible thing. The claimed “goals” and “process” do not define any structure that could possibly constitute a system (apparatus). With respect to claiming the “groups”, that applicant freely admits are groups of human beings, this is not an allowable statutory class of invention. Humans are not an apparatus and are not a process of doing anything. Applicant is very incorrect in their arguments that groups of people can be patented. 35 USC 101 specifically excludes humans from being claimed in apparatus types of claims. Humans can be part of process claims but cannot be claimed as an element of an apparatus type of claim, which is what applicant is doing. People are not “property” and cannot be owned. Claiming a system, where the only real world structure claimed are groups of humans, is essentially claiming the groups of people as an intellectual property right, which is not statutory.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1,2,5,6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Upon a review of the specification for guidance on how the claimed steps are to be executed and performed, it is found that there is no further discussion provided. Applicant has only disclosed an abstract idea of a general process that is not limited to anything specifically. With respect to practicing the claimed invention, one of skill in the art is left simply guessing as to how the claimed steps are supposed to be executed. The very purpose of patents is to convey useful information to the public so that further innovation is fostered. With this in mind, upon a review of the specification, it is not clear at all as to what applicant has allegedly invented other than just an abstract idea. The specification provides not details or guidance on how one of skill in the art should go about identifying an entry vehicle that is not too narrow but broad enough as claimed. Nothing is disclosed about how the step of "proving" is accomplished. What is required to do this step? This is not clear. The specification is so broad that it is not considered to be an enabling disclosure. If applicant has invented a new process as alleged, then what are the steps that are involved and how are they actually performed? This has not been disclosed. The specification does not provide enough information to enable one skilled in the art to practice the claimed invention without undue experimentation. Each step could feasibly be performed in different manners and one of skill in the art would have no idea what the actual "novel" method is. A person skilled in the art attempting to practice the claimed invention would more or less be left to himself or herself to develop the actual process itself and figure out how the claimed

steps are to be performed because applicant has not disclosed anything about the process that enables its use and practice, other than the abstract idea of the process itself. The claims are not enabled.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 1, with respect to the language “proving the technological concept for the entry vehicle application”, what is being proved? This is not claimed and renders the claim as indefinite. Applicant must claim what it is that is being provided to make it clear what is being claimed.

For claims 2,4,6, the scope of this claim is not clear at all. What does reciting that the entry vehicle application is “narrow enough in scope to reduce development time” and that it is “broad and flexible enough to be applicable to additional applications” mean? What does this require? What kinds of entry vehicle applications are inside the scope of this claim and what kinds are not? This is not clear. One wishing to avoid infringement would want to know what the metes and bounds of this claim is so they can ensure that they are not infringing. This language is so vague and unclear that one wishing to avoid infringement would not have been reasonably made aware of the

scope of this claim. This claim is indefinite and the examiner has no idea as to what the scope of this claim is.

For claim 3, it is not clear as to what the system is that applicant is attempting to claim. A system claim is this one is interpreted to be an apparatus type of claim. Nothing in the body of the claim is reciting anything that would constitute part of a system. “Goals” are not real world tangible things and are not recitations directed to structure of a system (apparatus). The “process” claimed is also not a real world thing but is an abstract idea. The claimed “groups” are really people, and they cannot define an apparatus. What is there claimed that can possibly constitute a system as far as an apparatus goes? Nothing has been claimed in the opinion of the examiner and because of this reason the claim is not definite. One wishing to avoid infringement would have no idea what the system is structurally that is being claimed. The language of “the decision process including identifying an entry vehicle application” leads the examiner to question if this is a method claim? How can applicant claim a method step as part of a system? IT is not clear what the system that is being claimed is made up of because nothing recited in the body of the claim defines any structure to any kind of system/apparatus.

For claim 5, it is not clear if technology is being developed or not. The claimed step of *“tasking the research group to develop technology for use in an entry vehicle application”* is just a step of tasking and does not necessarily require that the technology ever be developed. As an example, lots of students are tasked with homework, but not all of them do it. When applicant claims that additional applications are identified for the

technology developed, this causes confusion on the claim because it was never recited that any technology was ever developed. Does the claim scope actually require that the technology be developed? This is not clear to one wishing to avoid infringement in view of the claim language.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1,2, are rejected under 35 U.S.C. 102(b) as being anticipated by the article “The Global Positioning System”.

For claims 1,2, the article discloses that in a 1973 meeting at the Pentagon, the idea of a GPS system was conceived. This initial idea is the claimed “specific technological concept” that was identified and then developed into a product. The initial application (entry vehicle application) is the use by the military of the GPS system once it was operational. This was started in 1978 and was at full capacity and finished in 1993. The system proved it worked. It worked so well in fact that private companies pressured the United States government into allowing the GPS system to be used for commercial purposes. This is where the claimed identification of “additional applications” for the proven concept (GPS) is found. The proven concept of GPS was taken from the military and adapted for use in the civilian/commercial side. The article discloses some examples of the various products that have been developed based on

this initial concept of GPS that was developed in 1973. The various applications/products include many types of vehicles using GPS for accurate positioning and maps of routes, such as cars, trucks, boats, and planes. Another application is the use of GPS technology in mapping and surveying. Earthquakes and the shifting of the earth's tectonic plates are even disclosed as being monitored by using GPS technology. This article discusses a specific example of the broad abstract idea that is claimed in claims 1 and 2. The article on page 7 discloses "*The Pentagon made the GPS system available for commercial use only after being pressured by the companies that built the equipment and saw the enormous potential market for it*". The claimed "business" is the GPS development project itself and the reference discloses that the people that built the GPS system (the claimed product team) are the ones that developed it for use on the commercial side. This satisfies what is claimed. The ones that first built and developed the GPS for the military use also developed it for commercial use, which satisfies what is claimed.

9. Claims 1,2, are rejected under 35 U.S.C. 102(b) as being anticipated by the article "Adept, Adapt, Adopt, Three hurdles for new products".

For claims 1,2, the article discloses the idea of using military technology and developing new products from that technology. The military has developed a specific technological concept into an entry vehicle application. An example is found on page 815 where it is discussed that scientists and the Wright Laboratory developed some sophisticated electro-optics for a military purpose. The entry vehicle application is the

military use of the electro-optics. Then it is disclosed that the very same scientists became aware of another problem in the medical field. They applied their military developed electro-optics to make a medical breakthrough. This is the act of taking that entry vehicle application and identifying additional applications that it can be used in and developing a new product, where the same people were involved (claimed product team). This is the essence of this article. Take a proven technological concept and use it to develop and market new products.

10. Claims 3,4, are rejected under 35 U.S.C. 102(b) as being anticipated by Abelow (5251294).

For claim 3, the examiner has treated the claims as reciting nothing more than 3 groups of people that are able to do certain things. The claimed “goals” and “process” are not defining anything that is tangible and real. Weight is not given to these limitations in these system claims. The only real thing claimed is groups, which are actually groups of people. To that extent, Abelow in column 11, lines 12-36 discloses that with respect to a business that is trying to reach a goal for a particular product (doubling battery life), there are various departments involved such as a research and development team, product design and marketing, manufacturing, distribution channel, etc.. This anticipates what is claimed because there are 3 groups of people disclosed, which is what is claimed. People are inherently able to conduct research (just like the job of a patent examiner who is a human being), are able to adapt products, and are able to market products as claimed. The functional language about each group can

inherently be performed by groups of people, especially the groups of people disclosed by Abelow (research and development team, product design and marketing, manufacturing, distribution channel).

For claim 4, the “entry vehicle application” is not part of the system and is not a real world tangible thing that defines any structure to a system. This claim is not reciting anything further as far as structure goes and is satisfied by what is discussed for claim 3 above.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 5,6, are rejected under 35 U.S.C. 103(a) as being unpatentable over the article “The Global Positioning System”.

For claims 5,6, the article discloses that in a 1973 meeting at the Pentagon, the idea of a GPS system was conceived. The entry vehicle application is the use by the military of the GPS system once it was operational. This was started in 1978 and was at full capacity and finished in 1993. . The system worked so well that private companies pressured the United States government into allowing the GPS system to be used for commercial purposes. This is where the claimed identification of “additional applications” for the proven concept (GPS) is satisfied. The proven concept of GPS was taken from the military and adapted for use in the civilian/commercial side to develop new technology (GPS for the commercial or private sector). The article discloses some examples of the various products that have been developed based on this initial concept of GPS that was developed in 1973. The various applications/products include many types of vehicles using GPS for accurate positioning and maps of routes, such as cars, trucks, boats, and planes (even handheld devices). Another application is the use of GPS technology in mapping and surveying. Earthquakes and the shifting of the earth’s tectonic plates are even disclosed as being monitored by using GPS technology. The article on page 7 discloses “*The Pentagon made the GPS system available for commercial use only after being pressured by the companies that built the equipment and saw the enormous potential market for it*”. The claimed “business” is the GPS development project itself (military contractors) that build the system and the reference discloses that the people that built the GPS system are

the ones that developed it for use on the commercial side. The ones that first built and developed the GPS for the military also developed it for commercial use, which satisfies what is claimed. Not disclosed is that there was a research group, a product development group, and a commercialization group as claimed, where all of them selected the GPS system as an entry vehicle application. With respect to having a research group, a product development group, and a commercialization group, this would have been obvious to one of ordinary skill in the art and is really just claiming 3 different groups. The language describing what each group was tasked with is not further defining anything to the groups and is directed to non-functional descriptive material. Clearly when developing the commercial applications for the military GPS system, one of ordinary skill in the art would have found it obvious to have a research group, a product development group, and a commercialization group so that the new applications could be researched, developed and commercialized by the companies that pressured the government to allow the use of the GPS system for additional applications. The term "R&D", which is very well known to one of ordinary skill in the art, stands for research and development. Having research groups and development groups is nothing new and is obvious. With respect to the "commercialization group", the examiner sees this as being more or less a marketing group that is trying to market the product and bring it to market. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a "commercialization group" that markets the product, something that is very well known in the art. Clearly when one is developing a new product, such as new applications for a military GPS system, one has

to have a marketing plan. One of ordinary skill in the art is very aware of a marketing team that concentrates on marketing to bring the actual product or concept to market in a successful manner. With respect to having all 3 groups select the entry vehicle application, one of ordinary skill in the art at the time the invention was made would have found it obvious to have these 3 groups get together to decide on the entry vehicle application so that more input is gathered and more experienced people are in on the decision making process. One would expect that the more people you have looking at a problem or task, the more likely you are to get a better solution. This is a result that is predictable and would be expected.

14. Claims 3,4,5,6, are rejected under 35 U.S.C. 103(a) as being unpatentable over “Adept, Adapt, Adopt, Three hurdles for new products”.

For claims 3,4, the only things claimed that are real world are the “groups”. The groups are really just groups of people. The “goals” and “process” claimed define nothing structurally to a system. The article discloses on page 814 the existence of a “research department”, which is a research group. Also disclosed are “manufacturing people” that are to adopt new methods. This is considered to be the “development group” that is claimed. Not disclosed is a “commercialization group”. The examiner sees this as being more or less a marketing group that is trying to market the product and bring it to market. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a “commercialization group” that markets the product. All that is claimed is 3 groups of people, two of which are disclosed by the

article. Clearly when one is developing a new product, one has to have a marketing plan and one of ordinary skill in the art is very aware of having a team that concentrates on marketing and bringing the actual product to market in a successful manner. To add a commercialization group to the article is obvious to one of ordinary skill in the art.

For claims 5,6, the article discloses on page 814 the existence of a “research department”, which is a research group that develops new ideas and technology. Also disclosed are “manufacturing people” that are to adopt new methods. This is considered to be the “development group” that is claimed. The article discloses the idea of using military technology (technology in an entry vehicle) and developing new products from that technology. The military has developed a specific technological concept into an entry vehicle application. An example is found on page 815 where it is discussed that scientists and the Wright Laboratory developed some sophisticated electro-optics for a military purpose. *The entry vehicle application is the military use of the electro-optics.* Then it is disclosed that the scientists became aware of another problem in the medical field. They applied their military developed electro-optics (entry vehicle application) to make a medical breakthrough (an additional application as claimed). This is the act of taking that entry vehicle application (military technology) and identifying additional applications that it can be used in. Not disclosed is a “commercialization group”. The examiner sees this as being more or less a marketing group that is trying to market the product and bring it to market. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a “commercialization group” that markets the product, something that is very well known

in the art. Clearly when one is developing a new product, one has to have a marketing plan and one of ordinary skill in the art is very aware of having a team that concentrates on marketing to bring the actual product or concept to market in a successful manner. To add a commercialization group is obvious to one of ordinary skill in the art. With respect to the recitation of having all 3 groups decide on the entry vehicle application, this is not disclosed. One of ordinary skill in the art at the time the invention was made would have found it obvious to have these 3 groups get together to decide on the entry vehicle application so that more input is gathered and more experienced people are in on the decision making process. One would expect that the more people you have looking at a problem or task, the more likely you are to get a better solution. This is a result that is predictable and would be expected.

15. Applicant's arguments filed 12/27/07 have been fully considered but they are not persuasive.

With respect to the traversal of the 101 rejection that cited *In re Stephen W. Comiskey*, it is not persuasive. Applicant has argued that even if one or more of the claimed steps can arguably be characterized as mental steps, the "developing products" claimed step renders the claim statutory. The examiner disagrees, the claim is not statutory. Applicant has argued that the step of developing products is actually creating the products. The term "developing" is not the same as producing or making. The definition for "Develop" is "to bring out the capabilities or possibilities of, or to bring to a more advanced or effective state, or to cause to grow or expand, or to elaborate or

expand in detail (to develop a theory). This definition was taken from the "Random House College Dictionary, revised edition, 1982. The argument that the claimed step of "developing" actually requires that products are made or produced is not persuasive and is not supported by the definition for the term "develop". Applicant's argument is not commensurate with the scope of the claims. Because the claim scope does not require that any products actually be produced or manufactured, the rejection is proper. All of the steps can be done by people and nothing is being transformed into a different state by the claimed method steps. Applicant has also argued that the claims are also tied to two other statutory classes of invention, namely, a manufacture and a machine. What is meant by "manufacture" is not clear to the examiner. As far as a machine, none is claimed as being used in the claims. There is no use of any technology in the claims; the invention as claimed is not tied to a particular apparatus because none is even required. To argue that the machine that is used in the claims is "the development of new technology by the scientific development group, development of entry vehicles....,etc." is not persuasive. These things do not define a machine as they are not a device or an apparatus of any kind. Applicant seems to feel that a machine can be a process or an intangible concept or idea, which is not what was meant in the Comiskey decision. The claims are not considered to be statutory and the rejection will be maintained.

With respect to the traversal of the 101 rejection regarding the claimed process lacking in concreteness and not resulting in a tangible result, the argument is not persuasive. With respect to the tangible aspect, the examiner does not believe that the

claim produces a real world result. A marketable product conceptually (in an abstract sense) is not a real world result. Because no products are claimed as actually being produced, the result could just be a concept or an idea in an abstract sense. The result could just be a mental thought and this is not considered to be a real world result. With respect to the process being concrete, the recited steps could all be performed by people and the result obtained would not be the same for any two sets of people.

Taking into account that the specification fails to disclose any details on how these steps are actually supposed to be performed, two different sets of people practicing the claimed invention would not be expected to decide the same on any issue and would not be expected to make the same decisions for each step in the process. What one group of people arrives at would not necessarily be the same as the other group.

People's minds and their perceptions/opinions come into play and absent guidance on exactly how the steps are to be executed, the results obtained by two different sets of people would not be the same. This means that the claims are not considered to satisfy the concrete aspect under 35 USC 101.

With respect to the traversal of the 101 rejection for claims 3 and 4, it is not persuasive. Applicant has argued that just because the claims can include humans in their scope, this does not render the claims as non-statutory. Applicant has argued:

"While, as indicated in the specification, the groups may be staffed with scientists, engineers and/or business and marketing professionals, the groups themselves are not "human," but rather are man-made entities, or things, formed to accomplish specific goals. In addition to being staffed by scientists, engineers, and/or

business and marketing professions, such groups also include the various tools these professionals use to accomplish their tasked goals.”

This argument is not taken well in view of the disclosure in the specification. The specification stated that the groups are “generally made up of” people. This sure seems to be a definition that the group itself is made up of people. To argue that the groups are not human but are man made things is not persuasive because it is a group of people. Also, it was never stated that any various tools (computers or equipment) were included in the definition of the groups. To argue such is not supported by the disclosure as originally filed. As an example, the specification stated:

The product development group 14 is generally made up of engineers tasked with the job of transitioning the science or technology 5 developed by the research group into a reproducible and marketable product. For the purposes of this disclosure, the product development phase governed by the product development group is referred to as the integration phase.”

There is no discussion of computers or equipment being part of the group, just people. Another example is where the specification stated:

The commercialization group 16 is generally made up of people trained in product application engineering, business and marketing. Among other duties, the commercialization group is often charged with tailoring the core product to fit the needs of multiple markets and presenting marketable products to a new or existing customer base. For the purposes of this

disclosure, the commercialization phase is governed by the commercialization group.”

There is no discussion of computers or equipment being part of the group, just people. This is the case for all of the claimed groups. Applicant's argument that the groups include computers that engineers use to create drawings and computers with email programs is not supported by the specification and is not persuasive. Where does the specification disclose this definition or interpretation for the groups? The examiner cannot find any disclosure commensurate with what has been argued. Additionally, even if this were true and computers and equipment were part of the groups in addition to people, the fact that the claim scope includes or can read on humans as being the groups would still render the claims as non-statutory. If the claim scope includes statutory and non-statutory subject matter, the claims are properly rejected as being non-statutory until such as time as when the claims are limited to statutory subject matter. The claims are not statutory because the groups are people which is prohibited by 35 USC 101.

With respect to the 112,1st rejection and the traversal for claims 1,2,5,6, it is not persuasive. Applicant has relied upon the specification at page 5, lines 3-25 for enablement of the claims. This portion of the specification does mention the aspect of a memory storage device in a broad sense, but it does not disclose to one of skill in the art how to go about and actually execute the claimed steps. The specification provides no details or guidance on how one of skill in the art should go about identifying an entry vehicle that is not too narrow but broad enough as claimed. How exactly is this done?

How is the determination that it is not too narrow arrived at? How is the determination that it is not too broad arrived at? What factors are taken into consideration? This is not clear to one of skill in the art. Nothing is disclosed about how the step of “proving” is accomplished. What is required to do this step? How is this done? This is not clear. The specification is so broad and written in such as abstract sense that it is not considered to be an enabling disclosure for the method claims. If applicant has invented a new process as alleged, then how are the actual steps performed or executed? This has not been disclosed. The specification is just a description of an abstract process and is not disclosing how one of skill in the art can actually go about and do what is claimed. The argument is not persuasive.

With respect to the 112,2nd rejection and the traversal, it is not persuasive.

For claim 1, it is still not clear what is being proved because the claim never recites what it is. When one talks about proving something, the thing that they are trying to prove is disclosed. Claim 1 does not do this. Applicant has argued that the language means that the proving step is “*the establishment that it is an achievable end result.*”. This language is not in the claim and is not clear from the specification. This is also not in the specification. The argument is not persuasive.

For claims 2,4, and 6, applicant has relied upon the specification at page 5, lines 3-25. This portion of the specification does not overcome the rejection and does not provide anything that informs the examiner or one wishing to avoid infringement as to what the scope of the claim language is. It is not clear as to what the claim language

means that the examiner has addressed in the 112,2nd rejection. The argument is not persuasive.

With respect to claim 3, applicant has argued that the claim is directed to a system. The examiner takes the position that it is not clear what structure is being recited that could possibly define a system as far as an apparatus type of statutory claim goes. Applicant has requested that the examiner cite some case law that asserts that a system must be defined by “structure”. Well, the authority for this is set forth in 35 USC 101 because in an apparatus type of claim it is structure that is recited, not abstract ideas and intangible things such as “goals” or “processes”. Apparatus claims are things such as claims directed to chairs, computers, mailboxes, transponders, etc., all of which are real world tangible things that one can handle and touch. A goal is an abstract thing in one's mind and is not part of an apparatus. A process is also not a part of an apparatus, especially in the manner claimed. What is the structure claimed that can possibly define an apparatus? The examiner sees none. People are not human made in the sense that they can define an apparatus type of statutory claim. The claim is considered indefinite and the argument is not persuasive.

With respect to the 102(b) rejection in view of the article regarding the GPS system, the argument is not persuasive. The article on page 7 discloses “*The Pentagon made the GPS system available for commercial use only after being pressured by the companies that built the equipment and saw the enormous potential market for it*”. The claimed “business” is the GPS development project itself and the reference discloses that the people that built the GPS system (the claimed product team) are the ones that

developed it for use on the commercial side. This satisfies what is claimed. The ones that first built and developed the GPS for the military use also developed it for commercial use, which satisfies what is claimed. Applicant has also argued that the reference is not an enabling reference. This is just a general allegation on the part of the applicant and this kind of argument requires applicant to set forth why the reference does not teach to one of skill in the art how the practice the claimed invention. This has not been done. To the extent of what applicant has claimed, the article discloses the same. Applicant's argument is not persuasive.

With respect to the traversal of the AAA reference (Adept, Adapt, Adopt), the argument is not persuasive. Applicant argues that the reference does not identify a technological concept that is developed into a product. The examiner disagrees. The technology that was developed into a product is the electro-optics being used in the medical field. They used this technology to solve a 75 years old medical problem. It is specifically stated that they "applied their military development" to make a medical breakthrough. The medical breakthrough is the actual product that they developed. The argument is not persuasive. The examiner also notes that the claims never recite any specific technology or any specific products, so to argue that the prior art must disclose a specific product is not commensurate with the scope of the claims. The adept portion of the references specifically mentions that the company must have sufficient understanding of the technology used to develop and sell a product based on that technology. The argument that this reference deals with people happening upon or stumbling upon a discovery is not persuasive. It is specifically stated that they "applied

their military development" to make a medical breakthrough. This is not just stumbling on something as has been argued. Also just like the GPS reference, the argument that the AAA references is not enabled is not support by any showing from applicant of why.

Also in a general sense, if both the GPS reference and the AAA reference are not enabling because they do not disclose how the specific steps are accomplished, then this must also be applicable to the instant specification that also does not disclose how the claimed steps are actually performed. Applicant cannot argue that the disclosure is enabling, when the disclosure does not set forth any specifics, and then argue that the prior art is not enabling because it lacks specifics. Applicant cannot have it both ways. The instant specification also fails to document to one of skill in the art how to implement the method as claimed.

With respect to the traversal of the 102 rejection in view of Abelow, it is not persuasive. To the extent that applicant has claimed any structure that can possibly define a system, such structure is taught by the reference. Structure that defines a real world thing such as a device or apparatus is what is given weight in these claims, not intangible and abstract things such as goals and a process. Weight has been given to the elements that define structure, nothing more. To this extent, the prior art satisfies what is claimed. Also due to the indefiniteness of the claims, as they are best understood by the examiner, the prior art is properly applied. Limitations that are indefinite cannot be disregarded, but if it is not clear what they are or what they mean, an examiner cannot be expected to apply prior art to these limitations. The alternate is to not apply any prior art until the claims are definite, something the examiner does not

like to do. To the extent that applicant has claimed anything structurally, this has been treated and addressed in the prior art rejection. The argument is not persuasive.

With respect to the 103 rejection for claims 3-6 in view of the Adept, Adapt, Adopt" reference, the argument is not persuasive. Applicant has alleged that the reference is not enabling but has not provided any explanation or showing as to why it is not enabling. This argument is not persuasive and is just a general allegation not supported by any explanation or rationale. Applicant has argued that the claimed goals and process are limitations that must be in the prior art for the rejection to be proper. To the extent that applicant has claimed any structure that can possibly define a system, such structure is taught by the reference. Structure that defines a real world thing such as a device or apparatus is what is given weight in these claims, not intangible and abstract things such as goals and a process. Weight has been given to the elements that define structure, nothing more. The examiner notes that applicant has not actually argued the obviousness statement from the examiner and seems to have argued the rejection like it is a 102 type of rejection.

With respect to the traversal of the 103 rejection for claims 5 and 6, it is not persuasive. The rejection of record addresses the newly amended claim. The identifying of additional applications is addressed by the rejection. Applicant has simply stated that the prior art does not disclose what is claimed. Also, applicant should note the new grounds of rejection for these claims that was necessitated by amendment.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/

Primary Examiner, Art Unit 3689